

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

**Trademark Law Office 119**

**Trademark Examining Attorney: Charlotte K. Corwin**

Mark: **BACTRACK**

Applicant: KHN Solutions, Inc.

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**RESPONSE**

Honorable Commissioner for Trademarks

P.O. Box 1451

Alexandria, VA 22313-1451

The following is in response to the Office Action issued September 22, 2017 in this matter.

**IDENTIFICATION OF GOODS AND SERVICES**

Applicant hereby enters the following amended identification of goods:

**Class 9: Apparatus for recording, transmission, processing and reproduction of images or data; data-processing apparatus; calculating machines; computer peripheral devices; computers; wearable computers; software for recording, transmitting, processing and reproducing images or data in connection with the foregoing goods; none of the foregoing being for recording, transmission, production, reproduction and/or playback of sound; and none of the foregoing being touch pads**

The remainder of the identification of goods and services remains as presently worded.

**LIKELIHOOD OF CONFUSION REFUSAL**

The Examining Attorney has issued a likelihood of confusion refusal against the registration of Applicant's BACTRACK mark ("Applicant's Mark"), under Section 2(d) of the Trademark Act, based on a perceived likelihood of confusion with the following marks:

1. BACKTRACK, Reg. No. 3,646,327, owned by Line 6, Inc., for "apparatus for recording, transmission, or playback of sound" in International Class 9; and
2. BACKTRACK, Reg. No. 4,103,082, owned by Motorola Trademark Holdings, LLC for "touch pads for use in connection with cellular phones, computers and wireless communication devices for voice, data, or image" in International Class 9.

(Individually the “’327 Mark” and the “’082 Mark;” collectively the “Cited Marks” or “Cited Registrations”).

For the following reasons, Applicant respectfully requests that the Examining Attorney withdraw the Section 2(d) refusal with respect to both Cited Registrations.

The Goods Offered under the Marks are Not Related to Such a Degree That Confusion is Likely

In the refusal to register, the Examining Attorney argued that Applicant and the Registrants’ goods overlap, such that they could give rise to the mistaken belief that the goods emanate from the same source. In support of the theory that the goods overlap, the Examiner included evidence from the USPTO’s X-Search database consisting of a number of third-party marks registered for use in connection with the same or similar goods and/or services as those of both applicant and each of the registrants showing that the goods listed therein may emanate from a single source under a single mark.

Applicant respectfully asserts that the field encompassing peripherals, wearable computers, computer, and apparatus is broad and includes diverse and unrelated products within it. Furthermore, Applicant has amended the description of goods in the application to more accurately reflect the description of goods, specifically excluding (1) the recording, transmission, production, reproduction and/or playback of **sound** and (2) **touch pads** (the goods covered by the co-existing ’327 Mark and the ’082 Mark, respectively).

The Patent and Trademark Office and the Courts have consistently declared that goods or services are not “related” merely because they “co-exist in the same broad industry,” but are “related” if the goods or services are “marketed and consumed such that buyers are likely to believe that the services, similarly marked, come from the same source, or are somehow connected with or sponsored by a common company.” Homeowners Group, Inc. v. Home Mktg. Specialists, Inc., 931 F.2d 1100, 1109 (6th Cir. 1991); Electronic Data Sys. Corp. v. EDSA Micro Chip, 1992 T.T.A.B. LEXIS 4, \*11, 23, USPQ2d 1460, 1463 (T.T.A.B. 1992); Information Res. Inc. v. X\*Press Info. Serv., 6 USPQ2d 1034 (1988); Reynolds & Reynolds Co. v. I.E. Sys., Inc., 5 USPQ2d 1749, 1751 (T.T.A.B. 1987). In other words, it is necessary to assess whether the services offered under Applicant’s mark and the services offered under each of the Cited Marks are related to such a degree that they are likely to be linked in consumers’ minds. Fleischmann Distilling Corp. v. Maier Brewing Co., 314 F.2d 149, 159 (9th Cir. 1963) cert. denied, 374 U.S. 380 (1963).

In this case, the Examiner has determined that the co-existence of the goods in the same broad industry is probative of confusion. This conclusion does not consider the way the goods are marketed and consumed and how those details affect the likelihood of confusion. Applicant’s goods, as amended to more accurately reflect the nature of the goods, are not the same as the goods in either of the Cited Registrations.

Here, Applicant offers a product directed towards the monitoring of blood alcohol levels through images. As noted above and as reflected in the amended description of goods, the goods offered under Applicant’s BACTRACK mark do not cover the recording, transmission, production, reproduction and/or playback of sound, nor are Applicant’s goods touchpads. By

contrast, the goods offered under the Cited Registrations are for the playback of sound for a guitar riff recorder (the '327 Mark) and a touchpad feature (the '082 Mark) See Exhibit A. These differences create a conceptual gap between the goods that will prevent consumers from linking them in their minds.

The differences in the products also affects the ways they are marketed. Applicant's product is directed towards individuals interested in visually monitoring blood alcohol levels. The product offered under the '327 Mark are directed specifically towards guitar players and concern the playback of sound. With respect to the '082 Mark, BACKTRACK appears to be used in connection with a touchpad feature within the goods. Although the products offered under each of the Cited Registrations and Applicant's Mark fall into the same broad category, the consumers they serve may be differentiated as individuals interested in monitoring blood alcohol levels such as police officers or nurses (for purchasers of Applicant's goods), musicians (for purchasers of a guitar riff recorder), and cell phone manufacturers (touchpad feature). These purchasers will not seek or have a use for goods that are primarily used by the other class.

In these facts, the situation is analogous to King Research, Inc. v. Shulton, where the court found that there was no likelihood of confusion between SHIP-SHAPE for comb and brush cleaner and SHIP-SHAPE for hair spray because, among other factors, the products were intended for different purposes and were applied differently; additionally, the mere similarity of products as involving "hair grooming" was insufficient to support finding a likelihood of confusion. King Research, Inc. v. Shulton, 324 F. Supp. at 631, 169 USPQ at 396. Here, although the goods exist in the same broad industry, their purpose and application is so different that consumers are not likely to confuse them.

Because of the different nature of Applicant's and each of the registrant's goods and the different conditions under which they are consumed, the relevant goods are not marketed in such a way that they would be linked in consumers' minds. Thus, confusion is not likely.

#### The Parties' Marks Are Not Confusingly Similar

It is well-settled that in determining likelihood of confusion, the Examining Attorney must look at the marks in their entirety, for similarities in appearance, sound, connotation and commercial impression. *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357 (CCPA 1973).

As stated by the Court of Appeals for the Federal Circuit in *In re Hearst Corp.*, 25 USPQ.2d 1238, 1239 (CAFC 1992) "[m]arks tend to be perceived in their entirety, and all components thereof must be given appropriate weight." In the *Hearst* case, the Court found that the trademarks VARGAS and VARGA GIRL, both for calendars, were sufficiently different in sound, appearance, connotation and commercial impression to negate any likelihood of confusion. Further, in *In re Sears Roebuck and Co.*, the identical mark was found to have a different connotation and thus create a different commercial impression when applied to two different types of wearing apparel, namely, CROSS-OVER for brassieres and CROSSOVER for ladies' sportswear. 2 USPQ 2d at 1314.

Conflicting marks must be compared by looking at them as a whole, rather than breaking the marks up into their component parts, for comparison. It is the impression that the mark as a

whole creates on the average reasonably prudent buyer and not the parts thereof, that is important. As the Supreme Court observed: “The commercial impression of a trademark is derived from it as a whole, not from its elements separated and considered in detail. For this reason it should be considered in its entirety....” *Estate of P.D. Beckwith, Inc. v. Commissioner of Patents*, 252 U.S. 538 (1920).

The use of identical words, or even dominant words in common, does not automatically mean that the two marks are similar. *See, e.g., Shen Manufacturing Co. v. Ritz Hotel Ltd.*, 393 F.3d 1238 (Fed. Cir. 2004) (RITZ and THE RITZ KIDS create different commercial impressions); *In re Farm Fresh Catfish Co.*, 231 USPQ 495 (TTAB 1986) (CATFISH BOBBERS (with "CATFISH" disclaimed) for fish held not likely to be confused with BOBBER for restaurant services); *In re Shawnee Milling Co.*, 225 USPQ 747 (TTAB 1985) (GOLDEN CRUST for flour held not likely to be confused with ADOLPH'S GOLD'N CRUST and design (with "GOLD'N CRUST" disclaimed) for coating and seasoning for food items); *In re S.D. Fabrics, Inc.*, 223 USPQ 54 (TTAB 1984) (DESIGNERS/FABRIC (stylized) for retail fabric store services held not likely to be confused with DAN RIVER DESIGNER FABRICS and design for textile fabrics). Rather, in analyzing the similarities of sight, sound and meaning between two marks, a court looks to the overall impression created by the marks and does not merely compare individual features.

The Examining Attorney has argued that the marks are confusingly similar because Applicant's Mark is virtually identical to the marks in each of the Cited Registration, but for the “deletion of the letter ‘K.’” When viewed in their entireties, however, Applicant's Mark is not so similar to either of the Cited Marks as to cause confusion, mistake or to deceive. Applicant's Mark is at least, if not far more, different from each of the Cited Marks than the CROSS-OVER and CROSSOVER marks at issue in the *Sears Roebuck* case. Applicant's use of the BAC element is not a novel spelling or misspelling of the term “back,” as it would be had the letter “K” been merely deleted. Applicant's Mark is not a version of the directional indicator “back” or “backwards.” Rather, Applicant's use of BAC has a unique suggestive connotation in connection with the goods offered under the mark. By contrast, each of the Cited Registrations uses the phrase BACK as an indicator of movement, specifically as indicating a backwards directional motion such as in the play “back” of previously recorded sound (the '327 Registration) or the touch-pad functionality of a “back”ground screen (the '082 Registration). Accordingly, Applicant respectfully submits that Applicant's Mark is distinguishable from each of the Cited Marks.

For all of the above-reasons, the parties' marks are not confusingly similar.

### Conclusion

Applicant's identification of goods in International Class 9 features a very specific product associated with the monitoring of blood alcohol levels through images, which would not conceivably be considered encompassed by, or related to, either of the Cited Registrations' goods which are associated with the playback of guitar riff sounds (the '327 Mark) and touchpads (the '082 Mark).

Applicant respectfully submits that, as a result of the amended identification of goods in the application to exclude the goods related to sound and touchpads, and given that the differences in the conditions surrounding the marketing of the parties' respective goods is such that they would not be encountered by the same purchasers under circumstances that would give rise to the mistaken belief that they come from a common source, a likelihood of confusion between Applicant's Mark and each of the Cited Marks does not exist. *See On-Line Careline Inc., supra; In re Martin's Famous Pastry Shoppe, Inc., supra.*

The court in *Electronic Design & Sales, Inc. v. Electronic Data Systems Corporation*, 954 F.2d 713, 21 U.S.P.Q.2d 1388 (CAFC 1992) specifically indicated that it was "not concerned with mere theoretical possibilities of confusion, deception, or mistake or with *de minimus* situations but with the practicalities of the commercial world, with which the trademark laws deal."

In order to refuse registration of a mark Section 2(d), it is not sufficient that confusion is merely "possible." A higher standard is required. *See Shatel Corp. v. Mao Ta Lumber & Yacht Corp.*, 697 F.2d 1352, n.2, 220 USPQ 412 (11th Cir. 1983) (likelihood is synonymous with probability); *Rodeo Collection, Ltd. v. West Seventh*, 812 F.2d 1215, 2 USPQ.2d 1204, 1206 (9th Cir. 1987) ("Likelihood of confusion requires that confusion be probable, not simply a possibility."); *Blue Bell Bio-Medical v. Cin-Bad, Inc.*, 864 F.2d 1253, 9 USPQ.2d 1870, 1875 (5th Cir. 1989) ("[Plaintiff] must show, however, that confusion is probable; a mere possibility that some customers might mistakenly identify the [defendant's product] as [plaintiff's] product is not sufficient."). That requisite higher standard does not exist in the present case. Applicant respectfully asserts that if each of the Cited Registrations, which are identical to each other, can co-exist with one another without confusion in the marketplace, then Applicant's uniquely suggestive BACTRACK mark (which is different in sight, sound, and meaning from each of the Cited Registrations) can also co-exist. Moreover, the amended description of goods excluding "sound" and "touchpads" obviates any further potential for confusion.

Further, the statutes and regulations governing the issuance of trademark registrations permit any person who believes he or she may be damaged to file an opposition. Others engaged in the relevant business are in the best position to determine whether registration of a particular mark poses a risk of damage. *See In re Grand Metro. Foodservice, Inc.*, 30 USPQ2d 1974 (TTAB 1994); *In re Geo. Weston Ltd.*, 228 USPQ 57 (TTAB 1985); *In re Geo. A. Hormel & Co.*, 218 USPQ 286 (TTAB 1983); *In re Gourmet Bakers, Inc.*, 173 USPQ 565 (TTAB 1972). All doubts as to likelihood of confusion should therefore be resolved in favor of Applicant and the refusal to register under Section 2(d) should be withdrawn.

For the foregoing reasons, a likelihood of confusion does not exist between Applicant's Mark and each of the Cited Marks. Therefore, it is respectfully requested that the Section 2(d) refusal be withdrawn.

## **CONCLUSION**

Having resolved all outstanding issues, Applicant respectfully requests that the Examining Attorney approve the present application for publication in the *Official Gazette* at the earliest possible date.